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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,897	05/23/2001	Anna Karri	944-003.088	9365

4955 7590 12/09/2003

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EXAMINER

NGUYEN, JOSEPH D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 12/09/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,897

Applicant(s)

KARRI ET AL.

Examiner

Joseph D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4-5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Mochizuki et al. (6,044,248).

Regarding claim 21, Mochizuki et al. discloses a system, comprising:

i) an apparatus for conveying an ordered sequence of frames (images and text) of a message (abstract, fig. 4-5, col. 1 line 50 thru col. 2 line 33, col. 4 line 62 thru col. 6 line 6), at least one frame including both a picture and associated text (col. 1 lines 50-63), the message being conveyed at least in part using a bearer service of a wireless communications network (radio base station) (#101 fig. 1, col. 2 lines 45-56), the apparatus comprising:

a) means for assembling a plurality of frames of the message in a desired order (abstract, fig. 4-5, col. 1 line 50 thru col. 2 line 33, col. 4 line 62 thru col. 6 line 6), at

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least one frame including text and either a picture or a bookmark to a picture (col. 1 lines 50-63);

b) means for indicating a recipient of the message (fig. 6A-C, Fig. 9-10, col. 5 line 48 thru col. 6 line 6);

c) means for indicating that the message is to be sent to the indicated recipient (col. 5 line 48 thru col. 6 line 6); wherein the means for indicating that the message is to be sent to the indicated recipient requires on the part of a sender a single action to be performed for all of the frames of the message rather than for each frame of the message (transmit two or more images) (fig. 4-6, col. 1 line 50-63); and

ii) means for providing a picture in response to a request for the picture (fig. 4A-6C); thereby providing to the recipient a message consisting of a plurality of frames in the desired order (fig. 8-10, col. 1 line 5 thru col. 2 line 10, and col. 7 line 29 thru col. 8 lines 67) .

Regarding claim 23, Mochizuki et al. further discloses the system of claim 21, wherein the means for providing a picture in response to a request for the picture does so in response to an indication that the picture be downloaded for use in a message being composed (character code from memory to be edited) (abstract, fig. 1-11).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1-3, 5-9, 11-13, 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sivula (EP 1 091 601 A2) in view of Mochizuki et al. (6,044,248).

Regarding claim 1, Sivula discloses a method for conveying a message from a sending terminal to a receiving terminal over a telecommunications system that is at least in part a wireless telecommunications system (abstract, fig. 1-2), the method comprising the steps of:

a) assembling a plurality of frames (text and pictures or images) of the message in a desired order (form special content messages that include both text and images or pictures) (fig. 2-4, col. 7 lines 10-34), at least one frame including text and either a picture or a bookmark to a picture (Happy birthday OK) (fig. 2);

b) indicating a recipient of the message (fig. 2-4, col. 8 lines 13-38);

c) indicating that the message is to be sent to the indicated recipient (fig. 2-4, col. 8 lines 13-38). However, Sivula does not specifically disclose wherein the step of indicating that the message is to be sent to the indicated recipient is performed once for all of the frames of the message rather than for each frame of the message, thereby providing to the recipient a message consisting of a plurality of frames in the desired order.

Mochizuki et al. teaches wherein the step of indicating that the message is to be sent to the indicated recipient is performed once for all of the frames of the message rather than for each frame of the message, thereby providing to the recipient a message consisting of a plurality of frames in the desired order (transmit a synthetic image which consists of two or more images) (abstract, fig. 5, col. 1 line 50 thru col. 2 line 33). Therefore, it would have been obvious to one skill in the art at the time the invention was made to modify the Sivula system with the teaching of Mochizuki et al. of transmitting all of the frames at one time in order to allow recipient to receive a message with all the images and texts and display them one by one.

Regarding claim 2, Sivula further disclose the method of claim 1, further comprising the step of associating with a frame of the message a special effect to be performed when the frame is displayed (messaging with full content versatility, including images, audio, video, data and text which means the special effect is associated with each frame when displaying) (col. 2 lines 17-36).

Regarding claim 3, Sivula further discloses the method of claim 2, further comprising the step of reviewing (checking) properties of a frame of the message, including whether or not a special effect has been associated with the frame (fig. 5, col. 11 lines 19-54).

Regarding claim 5, Sivula further discloses the method of claim 1, further comprising the step of preparing a frame of the message by indicating a picture to be

displayed in the frame and by providing text to be displayed in the frame (abstract, and fig. 2).

Regarding claim 6, Sivula further discloses the method of claim 1, further comprising the step of downloading (retrieve from short message service) from a service an already-created message (abstract, col. 8 line 39 thru col. 9 line 34), and editing (composing special content messages) the text of a frame of the message to personalize the message for use as a message to an assumed operator of the receiving terminal (fig. 2-4, col. 9 line 7 thru col. 10 line 35).

Regarding claim 7, Sivula further discloses the method of claim 1, further comprising the step of downloading from a service (abstract) or retrieving from stored memory of the sending terminal an already-created picture for use as the picture of a frame of the message and providing text to be associated with the picture (fig. 2-4, col. 9 line 7 thru col. 10 line 35).

Regarding claim 8, Sivula further discloses the method of claim 1, wherein the message is provided using a pre-existing message service selected from the group consisting of short message service (SMS), extended message service (EMS), and multimedia messaging service (MMS) (fig. 1, col. 7 line 11 thru col. 8 line 11).

Regarding claim 9, Mochizuki et al. further discloses the method of claim 1, wherein the message consists of three ordered frames (two or more images), each frame consisting of a picture and associated text personalized for an intended recipient (fig. 4-11, col. 1 line 50 thru col. 33). Therefore, it would have been obvious to one skill

in the art at the time the invention was made to modify the Sivula system with the teaching of Mochizuki et al. of ordered frames in order to allow recipient to receive total message at one time.

Regarding claim 11, Sivula discloses an apparatus for conveying a message from a sending terminal to a receiving terminal over a telecommunications system that is at least in part a wireless telecommunications system (abstract, fig. 1-2), the method comprising the steps of:

a) assembling a plurality of frames (picture or image) of the message in a desired order (from special content messages that include both text and images or pictures) (fig. 2-4, col. 7 lines 10-34), at least one frame including text and either a picture or a bookmark to a picture (fig. 2);

b) indicating a recipient of the message (fig. 2-4, col. 8 lines 13-38);

c) indicating that the message is to be sent to the indicated recipient (fig. 2-4, col. 8 lines 13-38). However, Sivula does not specifically disclose wherein the step of indicating that the message is to be sent to the indicated recipient is performed once for all of the frames of the message rather than for each frame of the message, thereby providing to the recipient a message consisting of a plurality of frames in the desired order.

Mochizuki et al. teaches wherein the step of indicating that the message is to be sent to the indicated recipient is performed once for all of the frames of the message rather than for each frame of the message, thereby providing to the recipient a message

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consisting of a plurality of frames in the desired order (transmit a synthetic image which consists of two or more images) (abstract, fig. 5, col. 1 line 50 thru col. 2 line 33).

Therefore, it would have been obvious to one skill in the art at the time the invention was made to modify the Sivula system with the teaching of Mochizuki et al. of transmitting all of the frames at one time in order to allow recipient to receive a message with all the images and texts and display them one by one.

Regarding claim 12, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 13, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 15, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 16, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 17, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 9.

5. Claims 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sivula (EP 1 091 601 A2) in view of Mochizuki et al (6,044,248) and further in view of Hiroaki (5,786,846).

Regarding claim 4, in the modify Sivula system, Sivula further discloses the method of claim 2, the special effect. However, Sivula does not specifically disclose the special effect is selected from the group consisting of vibrating the frame, providing a sound when the frame is first displayed, providing a sound when the frame is closed, opening the frame in stages, and closing the frame in stages.

Hiroaki teaches the special effect is selected from the group consisting of vibrating the frame (col. 10 lines 29-44, and col. 13 lines 7-25), providing a sound when the frame is first displayed, providing a sound when the frame is closed (col. 10 lines 29-44, and col. 13 lines 7-25), opening the frame in stages, and closing the frame in stages (col. 10 lines 29-44, and col. 13 lines 7-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Sivula system with the teaching of Hiroaki of special effect in order to make the message more special to the recipient.

Regarding claim 14, this claim is rejected for the same reason as set forth in claim 4.

6. Claims 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sivula (EP 1 091 601 A2) in view of Mochizuki et al (6,044,248) and further in view of Van Wie et al. (5,943,422).

Regarding claim 10, in the modify Sivula system, Sivula further discloses the method of claim 1. However, Sivula does not specifically disclose wherein the message is protected from being copied using a form of protections selected from the group consisting of: copy protection, digital rights management, and encryption.

Van Wie et al. teaches the method of the message is protected (col. 4 lines 40-51) from being copied using a form of protections selected from the group consisting of: copy protection (co. 22 lines 1-22), digital rights management (title), and encryption (col. 16 line 60 thru col. 17 line 20). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Sivula system with the teaching of Van Wie et al. of protection in order to secure the secret information from unauthorized users.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 10.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki et al. (6,044,248) in view of Smethers (6,560,640).

Regarding claim 22, Mochizuki et al. further discloses the system of claim 21, wherein the means for providing a picture in response to a request for the picture (fig. 8-

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10, col. 1 line 5 thru col. 2 line 10, col. 5 lines 21-27, and col. 7 line 29 thru col. 8 lines 67). However, Mochizuki et al. does not specifically disclose providing a picture in responses to a request also does in response to a bookmark according to the wireless application protocol (WAP).

Smethers teaches providing a picture in responses to a request also does in response to a bookmark according to the wireless application protocol (WAP) (abstract, fig. 3-9, col. 9 line 40 thru col. 10 line 65). Therefore, It would have been obvious to one skilled in the art at the time the invention was made to modify Mochizuki et al. with the teaching of Smethers of providing the bookmark in order to help the user to select a bookmark to request the associated document or file with reduced user interaction.

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA. Sixth floor (Receptionist).


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Nguyen whose telephone number is (703) 605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph Nguyen



Dec 5, 2003



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